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09/518,787	03/03/2000	Kurt Clement	108298627US	7353

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EXAMINER

REAGAN, JAMES A

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3621

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/518,787
Filing Date: March 03, 2000
Appellant(s): CLEMENT, KURT

Stephen E. Arnett
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09 September 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-29 stand or fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,438,508 A Wyman 08-1995

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

EXAMINER'S NOTE: The Examiner is issuing a new grounds of rejection under 37 CFR 41.39 of the MPEP. This revised rejection is based upon the same prior art as cited in the final Office action. See MPEP § 41.39 (a)(2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's own admission in view of Wyman (US 5,438,508).

Claims 1, 10, and 21:

The Examiner takes **Official Notice** that it is old and well known in the computer arts to sell computers with software already installed on the machine's hard disk. The Windows operating system, various third-party applications, and online services such as America Online,

Prodigy, and MSN are all preinstalled on a computer when it comes from the factory to the new owner. In support, Wyman discloses, "Each licensed product upon start-up makes a call to a license server to check on whether usage is permitted, and the license server checks a database of the licenses, called product use authorizations, that it administers," inherently disclosing recordation of access privileges and the following limitations:

- *recording data on a fixed medium in the computer system; and*
- *providing for transfer of the computer system to the user.*

With regard to the limitations of:

- *controlling access to the data through computer executable code that requires authorization for continued access to the data by automatically:*
- *detecting access to the data by the user, and*
- *querying the user's account, and if permission to continued access is verified, then enabling continued access to the data.*

Wyman, in at least column 1, lines 36-38 discloses, "...usage of licensed software may be monitored in a computer system to determine if a use is within the scope of a license", and product use authorizations (see at least the abstract). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the well-known method of pre-installing software onto a newly-purchased computer with Wyman's technique of enforcing usage rights and download privileges because this would entitle an authorized user to access digital data while preventing the unauthorized use of the same.

With regard to the limitations of *granting access to data after contacting the a party, recording the authorization, and granting a second access to the data based on the recorded authorization*, Wyman discloses a database interface and a log function, and a management interface which directs the access of the user (see at least column 11, lines 36-58). It would have been obvious to one of ordinary skill in the art at the time of the invention to grant repeated access to the data if the user is authorized. Wyman also discloses different types of licenses,

which inherently disclose repeated access to the data (see at least column 20, lines 13-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide multiple and repeated access to data because this provides an efficient and cost-effective means for distributing applications and data to individual and group users.

With regard to the limitation of *recording authorizations within the user computer system*, Wyman in at least column 23, lines 11-37 discloses storing the authorization handle on the client computer for future reference, and in at least column 4 lines 38-42 and lines 46-50 discloses that it was common practice in the art at the time of the invention to maintain individual licenses and store the license privilege proofs on each client system. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize this technique in combination with the known standard of pre-installing software because, "Such a licensing scheme makes it possible to charge customers only for the specific number of clients they purchase" (Wyman column 4, lines 42-44).

Claim 2:

The combination of Applicant's own admissions and Wyman disclose the digital data access system as shown above. Applicant/Wyman do not disclose *the act of recording data on the fixed medium includes recording software application program instructions on the fixed medium*. However, the Examiner takes **Official Notice** that it would have been old and well known in the computer arts at the time of the invention to install on the hard drive self-executing programs that automatically install and application when activated. AOL routinely places a shortcut onto the desktop of a new computer wherein a new user can click on the shortcut and the application will install the browser software and automatically connect to the Internet to begin setting up an account.

Claims 3, 11, and 22:

The combination of Applicant's own admissions and Wyman disclose the digital data access system as shown above. Applicant/Wyman do not disclose *recording software application program instructions on the fixed medium includes recording software application program instructions that enable a software application that does not depend on continued access to a network for fully functional operation*. However, Wyman, in at least column 2, lines 42-44 discloses a spreadsheet program. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the well-known method of pre-installing software onto a newly-purchased computer with Wyman's technique of installing stand-alone applications because this would entitle an authorized user to access digital data while preventing the unauthorized use of the same.

Claims 4-9 and 12:

The combination of Applicant's own admissions and Wyman disclose the digital data access system as shown above. Applicant/Wyman do not disclose:

- *the act of recording data on the fixed medium includes recording data on a hard disk drive.*
- *the act of controlling access to the data includes the computer system automatically executing computer readable instructions to contact a party authorized to grant access to the data.*
- *executing computer readable instructions includes executing instructions to activate a network link.*
- *executing computer readable instructions includes executing instructions to activate access to the Internet.*
- *the act of controlling access to the data includes determining if a user has a sufficient account credit to continue access to the data.*

- *the act of controlling access to the data includes determining if a user should be billed for accessing the data.*

However, the Examiner takes **Official Notice** that it is old and well known in the computer arts to install a self-extracting, self-executing program onto the hard drive of a computer, automatically dial up an ISP after installation, access the Internet, verify available credits (free hours) according to a sponsored program, and set up a billing account with a user's credit card. Applicant has referenced AOL in the section of the specification marked "Background of the Invention", and, as one of ordinary skill in the art would agree, AOL anticipates these steps when providing Internet access to a new customer for the first time.

Claims 13 and 23:

The combination of Applicant's own admissions and Wyman disclose the digital data access system as shown above. Applicant/Wyman do not disclose *verifying authority to access the software application verifies authority of a particular user to access the software application*. However, Wyman, in at least column 1, lines 36-38 discloses, "...usage of licensed software may be monitored in a computer system to determine if a use is within the scope of a license." It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the well-known method of pre-installing software onto a newly-purchased computer with Wyman's technique of enforcing usage rights and download privileges because this would entitle an authorized user to access digital data while preventing the unauthorized use of the same.

Claims 14 and 24:

The combination of Applicant's own admissions and Wyman disclose the digital data access system as shown above. Applicant/Wyman do not disclose *verifying authority to access the software application verifies authority of an accessing computer system to access the software application*. Wyman, however, discloses distributing software licenses among the units

of an organization (see at least column 2, lines 22-40). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the well-known method of pre-installing software onto a newly-purchased computer with Wyman's technique of enforcing usage rights and licensing privileges because this would entitle an authorized user to access digital data while preventing the unauthorized use of the same.

Claims 15-20 and 25-29:

The combination of Applicant's own admissions and Wyman disclose the digital data access system as shown above. Applicant/Wyman do not disclose:

- *verifying authority to access the software application is accomplished through a network connection.*
- *verifying authority to access the software application is accomplished through an Internet interface.*
- *if authority is not verified, then interrupting access to the software application.*
- *if authority to access the software application is not verified, then the user is presented with an opportunity to qualify for access to the software application.*
- *the opportunity to qualify for access to the software application includes generating a request to set up an account.*
- *if authority to access the software application is not verified, then the user's access to the software application is terminated.*

However, the Examiner takes **Official Notice** that it would have been old and well known in the computer arts at the time of the invention to check a password or authorization code across an Internet connection using a web browser, denying access if the code is incorrect, applying for an account, and terminating the session if an account is not requested or granted. Applicant has referenced AOL in the section of the specification marked "Background of the

Invention", and, as one of ordinary skill in the art would agree, AOL anticipates these steps when providing Internet access to a new customer for the first time.

(11) Response to Argument

Issue A

Appellant asserts that Applicant's own admission with regard to AOL in combination with Wyman do not disclose recording a data access authorization in the same computer system in which the data is stored. Assuming for the sake of the current argument that the computer system in question and relied upon by the Appellant is in the form of a client machine and not a system of networked computers such as, for example, an LAN/WAN or corporate intranet, the combination of Applicant's own admissions and Wyman disclose the digital data access system, as shown above. Wyman, in at least column 23, lines 11-37, specifically teaches storing the authorization handle on the client computer for future reference, and in at least column 4 lines 38-42 and lines 46-50 discloses that it was common practice in the art at the time of the invention to maintain individual licenses and store the license privilege proofs on each client system. Appellant's use of the Fortran Language Reference Manual is questionable at best not only because it provides no verifiable publication date, but also because there is no teaching within the specification or any of the prior art of reference that mandates that the any of the systems in question be written only in FORTRAN. Moreover, even if the systems of Wyman, AOL, and the Appellant's claimed invention were implemented by solely using a FORTRAN-based architecture, Wyman's disclosures would still trump any supposed linkage between the Appellant's inadequately defined handle and the technique of maintaining authorization proofs locally on a client or user machine.

Issue B

Appellant asserts that Applicant's own admission with regard to AOL in combination with Wyman does not include a teaching or suggestion that would make the combination obvious with a reasonable expectation of success. Applicant's voluntary admissions regarding the state of the art and the examples provided were given full faith and credit by the Examiner as testimony by one of at least ordinary skill in the art at the time the invention was conceived. Therefore, the Examiner dutifully accepts the Appellant's background information as factual. Because both the background of the Appellants application and Wyman are explicitly concerned with the proper and authorized use of sensitive digital material, the prior art is analogous. In addition, because both the background and Wyman disclose techniques for maintaining only authorized use of digitized files by placing digital data on a client's hard drive, the motivation to combine is provided with the expected and desired result of maintaining positive control over proprietary digital data. As is well-known in the computing arts, AOL is routinely installed on new computers before provision to the end user. In addition, AOL only provides access to their facilities after proper registration and payment. Wyman goes a step further by showing that downloadable data may be utilized by securing the proper access rights stored on the end user's computer. One of ordinary skill in the art which conclude that it is an obvious modification to store authorization data on a hard drive in light of AOL's technique of pre loading software onto a computer before the computer shipped to user and Wyman's use of storing an authorization handle on the computer's hard drive.

For the above reasons, it is believed that the rejections should be sustained.

Application/Control Number:
09/518,787
Art Unit: 3621

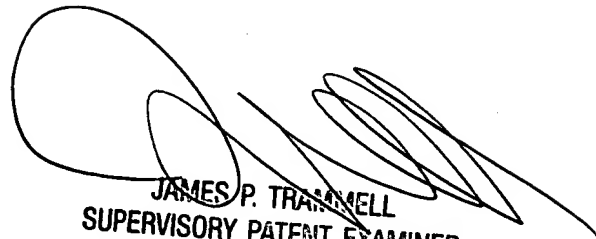
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Respectfully submitted,

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Examiner
Art Unit 3621
November 28, 2004

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